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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,318	01/23/2004	Rodger A. Lisk	461-001	.8185

7590 03/22/2007  
John G. Chupa  
Law Offices of John Chupa and Associates, P.C.  
Suite 50  
28535 Orchard Lake Rd.  
Farmington Hills, MI 48334

EXAMINER
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LE, HUNG CHARLIE

ART UNIT	PAPER NUMBER
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3663

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/764,318	<b>Applicant(s)</b> LISK ET AL.	
	<b>Examiner</b> Hung C. Le	<b>Art Unit</b> 3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 17 - 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17 - 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                                  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>06/28/2006</u> . | 6) <input type="checkbox"/> Other: _____   |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 17 – 22 in a phone interview on 03/14/2007 have been considered but are moot in view of the new ground(s) of rejection.

### ***Election/Restrictions***

2. Applicant's election with traverse of Species in Figure 4 in the reply filed on 06/28/2006 is acknowledged. The traversal is on the ground(s) that:  
No reason was given. Therefore, it is treated as no traverse.  
The requirement is still deemed proper and is therefore made FINAL.

Note: Original claims 1 – 16 were cancelled by applicant.

Claims 17 – 22 were added by applicant.

### ***Claim Objections***

3. Claim 20 is objected to because of the following informalities:

“ ...wherein said second and said fifth blade...”

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Should be: "...wherein said second blade and said fifth blade...".

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "...substantially the same number of carbide blades..." is vague/unclear do not what "substantially" is referred to.

Claim 21 recites the limitation "the same number" in lines 2 & 3. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 17 – 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stoyhoff, Jr. (5,682,784) in view of Admitted Prior art (APA). Stoyhoff, Jr. discloses applicant claim limitations except for alternating blade materials between steel and carbide (as taught by APA pages 4 & 5 of Specification).

With respect to claim 17:

Stoyhoff, Jr. discloses: A tooling assembly comprising:

a first rotatable member (14) having a first blade (fin blade of 16, highest blade of 14 below 12 in Fig. 1) which is comprised of only steel, a second blade (fin blade of the left hand side of the highest 16) which is comprised of only steel, and a third blade (fin blade of the right hand side of the highest 16 of rotatable member 14) which is comprised only of steel, wherein said second and third blades are respectively and operatively disposed at opposite sides of said first blade, thereby causing said first blade to be operatively positioned between said second blade and said third blade (see Fig. 1);

a second rotatable member (12) having a fourth blade [fin blade of the lowest blade (16) of (12) right above 14] which is comprised only of steel and which is disposed directly above and which overlays said first blade (see Fig. 1), a fifth blade

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[fin blade left hand side of the lowest (16) of (12) looking down top to bottom of Fig. 1] which is comprised of only steel, and a sixth blade [fin blade right hand side of the lowest (16) of (12)] which is comprised only of steel, wherein said fifth and sixth blades are respectively and operatively disposed at opposite sides of said fourth blade, thereby causing said fourth blade to be operatively positioned between said fifth blade and said sixth blade (Fig. 1);

wherein said first blade is constrained to selectively and cuttingly engage only said fifth blade, and wherein said second blade is constrained to cuttingly engage only said fourth blade; thereby causing said tooling assembly to operatively and selectively perform a desired operation on a sheet of material ( A) in a desired manner (arrow A) [As the rotatable members (14) and (12) turn in a clockwise direction, fin blade of blade 1 is constrained to selectively and cuttingly engage only the fin blade of blade 5, and the fin blade of blade 2 is constrained to cuttingly engage only the fin blade of blade 4; thereby causing the tool assembly to operatively and selectively perform a desired operation on a sheet of material (a) in a desired manner (arrow A)].

While patent drawings are not drawn to scale, relationships clearly shown in the drawings of a reference patent cannot be disregarded in determining the patentability of claims. See In re Mraz, 59 CCPA 866, 455 F.2d 1069, 173 USPQ 25 (1972).

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the tooling assembly as disclosed by Staynoff, Jr. by the teaching of APA to alternately replacing steel blades with carbide blades for economical and longevity advantages as such a modification is no more than the work of an expedient within the art.

With respect to claim 18:

Stoynoff, Jr. further discloses:

Wherein said first blade and said fourth blade are substantially the same size and shape (see Figs. 1 & 2).

With respect to claim 19:

Stoynoff, Jr. further discloses:

Wherein said third blade and said sixth blade are substantially the same size and shape (see Figs. 1 & 2).

With respect to claim 20:

Stoynoff, Jr. further discloses

Wherein said second and said fifth blade are substantially the same size and shape (see Figs. 1 & 2).

With respect to claim 21:

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Stoynoff, Jr. further discloses:

Wherein said first rotatable member (14) and said second rotatable member (12) contain substantially the same number of steel blades, and said substantially the same number of steel blades (See Figs. 1 & 2).

With respect to claim 22:

Stoynoff, Jr. discloses:

A tooling assembly comprising a first member (12) having a first plurality of blades made only from steel and a second plurality of blades made only from steel, wherein each of said second plurality of blades are respectively and operatively positioned between a respective and unique pair of said first plurality of blades; a second rotatable member (14) having a third plurality of blades made only from steel and a fourth plurality of blades made only from steel; wherein each of said fourth plurality of blades are respectively and operatively positioned between a respective and unique pair of said third plurality of blades; wherein each of said first plurality of blades only respectively and cuttingly engage a unique one of said fourth plurality of blades without cuttingly engage one of said third plurality of blades, and wherein each of said second plurality of blades respectively and cuttingly engage a unique one of said third plurality of blades without cuttingly engage one of said fourth plurality of blades, thereby causing said tooling assembly to operatively and selectively perform a desired operation on a sheet material in a desired manner and wherein each unique one of said steel blades of said rotatable member (12) is



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deployed above and overlays a unique one of said carbide blades of said second rotatable member (14) (See Figs. 1 & 2).

8. The statements of intended use or field of use, e.g., "having..., wherein..., causing..., thereby..., perform..., etc..." clauses are essentially method limitations or statements of intended or desired use.

Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See In re Pearson, 181 USPQ 641; In re Yanush, 177 USPQ 705; In re Finsterwalder, 168 USPQ 530; In re Casey, 512 USPQ 235; In re Otto, 136 USPQ 458; Ex parte Masham, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.


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**Conclusion**

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung C. Le whose telephone number is 571-272-8757. The examiner can normally be reached on M-F: 07:30am - 05:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack W. Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HCL  
03/14/07

  
JACK KEITH  
SUPERVISORY PATENT EXAMINER